

Amendment dated: November 6, 2003

Application Serial No.: 09/455,534

Attorney Docket No. 23453-035

In Response to Office Action mailed July 11, 2003

REMARKS

In response to the Office Action mailed July 11, 2003 (Paper No. 17), claims 19 and 20 have been cancelled without prejudice or disclaimer, claims 1, 7, 10, & 16 have been amended, and claim 23 has been newly added. Therefore, claims 1-18 and 23 are pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

A. INTERVIEW

Examiner Ming Chow and Primary Examiner Scott Weaver are thanked for the courtesies extended to Applicants' representatives (Mr. Blaise and Mr. Toering) during the personal interview on November 4, 2003. A summary of the substance of the interview was provided by Examiner Chow (and signed by Primary Examiner Weaver). *See* Interview Summary, Paper No. 18.

B. REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 7 and 16 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Examiner has referenced the term "TML" in claims 7 and 16. *See* Paper No. 17, pg. 2. Applicants disagree, as ample support may be found in the

Amendment dated: November 6, 2003

Application Serial No.: 09/455,534

Attorney Docket No. 23453-035

In Response to Office Action mailed July 11, 2003

Specification for "Telecaster Markup Language (TML)." *See*, e.g., pg. 18, line 14; pg. 37, line 15; and pg. 43, line 16. However, solely in the interest of expediting prosecution, claims 7 and 16 have been amended to recite that the markup documents comprise extensible markup language (XML) documents. As such, withdrawal of this rejection is earnestly sought.

C. **REJECTIONS UNDER 35 U.S.C. §103**

Claims 1-4, 7-13, and 16-20 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,915,001 to Uppaluru in view of U.S. Patent No. 6,385,191 to Coffman *et al.* ("Coffman"). Claims 5, 6, 14, and 15 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Uppaluru and Coffman, further in view of U.S. Patent No. 5,996,006 to Speicher. *See* Paper No. 17, pg. 3, ¶1 and pg. 5, ¶2. Applicants traverse.

Independent claims 1 and 10 each recite the feature of initializing outbound voice-enabled communications to one or more subscribers using one or more markup documents. In the Office Action, the Examiner concedes that Uppaluru fails to disclose this claim element. *See* Paper No. 17, pg. 3, ¶1. The Examiner relies on Coffman, however, for this feature:

"Coffman et al teach on column 3 line 20 to column 4 line 52 the telephone gateway uses markup web page to initiate an outbound call." *See* Paper No. 17, pg. 3, ¶1.

The rejection of independent claims 1 and 10 is improper as there exists no teaching, suggestion, or motivation to modify Uppaluru to include the teachings of Coffman. Assuming arguendo that there was a teaching, suggestion, or motivation to combine the two references, the

Amendment dated: November 6, 2003

Application Serial No.: 09/455,534

Attorney Docket No. 23453-035

In Response to Office Action mailed July 11, 2003

rejection would still be improper as Uppaluru and Coffman, even when combined, fail to disclose, teach or suggest all of the claim elements.

In particular, Coffman appears to disclose a system and method for converting a user's Internet call to a telephone call, and for connecting the telephone call to a call center as an inbound call, via a telephone gateway (104). Coffman discloses achieving this functionality by, in part, executing an applet (117) at a client (100) to initiate a call. See, e.g., FIGS. 1-2 and col. 3, line 30 – col. 4, line 52. Coffman fails to disclose, however, initiating an outbound voice-enabled communication to one or more subscribers using one or more of the markup documents.

For *at least* this reason, Applicants submit that none of the references cited by the Examiner, either alone or in combination, teach all of the limitations of independent claims 1 and 10. Specifically, the addition of Coffman does not cure the deficiencies in the disclosure of Uppaluru as conceded by the Examiner. Accordingly, Applicants further submit that dependent claims 2-9 and 11-18 are allowable because they depend from allowable independent claims, as well as for the further limitations they contain.

Amendment dated: November 6, 2003

Application Serial No.: 09/455,534

Attorney Docket No. 23453-035

In Response to Office Action mailed July 11, 2003

CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: November 6, 2003

By:


Bradford C. Blaise
Registration No. 47,429

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY, AND POPEO, PC
12010 Sunset Hills Road
Suite 900
Reston, Virginia 20190
(703) 464-4800 (Telephone)
(703) 464-4895 (Facsimile)

RES 104592v1